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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/812,796

03/30/2004

Suping Lyu

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12/16/2005

MEDTRONIC, INC.

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MINNEAPOLIS, MN 55432-9924

EXAMINER

HARVEY, JAMES R

ART UNIT

PAPER NUMBER

2833

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/812,796	<b>Applicant(s)</b> LYU ET AL.	
	<b>Examiner</b> James R. Harvey	<b>Art Unit</b> 2833	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-113 is/are pending in the application.
- 4a) Of the above claim(s) 61-74 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 14-33, 35, 36, 40, 44-60, 75, 76, 83-96, 98, 100 and 102-113 is/are rejected.
- 7) ☒ Claim(s) 4, 7-13, 34, 37-39, 41-43, 77-82, 97, 99 and 101 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3-30-04</u> . | 6) <input type="checkbox"/> Other: _____  |

## ***DETAILED ACTION***

### ***Election/Restrictions***

-- Applicant's election with traverse of species election requirement dated 10-03-05 is acknowledged. The traversal is on the ground(s) that all the search is not a burden. This is not found persuasive because the method claims 61-74 are classified in a different class and the meets and bounds of the method claims can only be properly searched and examined by an examiner trained in the unique class.

--- Claims 61-74 are withdrawn as being drawn to non elected claims.

-- The restriction requirement is deemed proper and made final.

### ***Claim Rejections - 35 USC § 112***

- The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- Claim(s) the following claims is/are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

-- In reference to Claim(s) 1-60 and 94-113, the recitation, line 4, of a seal zone element positioned adjacent the contact element conflicts with the recitation, lines 14-16, of the contact supporting protrusion being longitudinally spaced apart from the seal zone supporting protrusion, since the contact element is mounted upon the contact supporting protrusion and the seal zone element is mounted upon the seal zone supporting protrusion. An examination based on the merits, as best understood, is addressed below.

-- In reference to Claim(s) 10,40,79, and 101, the recitation “a one of the contact” is vague and indefinite also, the claims refer to a stop which is not addressed in claim 1. The claims can not be further examined.

-- In reference to Claim(s) 15 and 45, the recitation “ a second part” is not mention in the specification in order to understand what structure or the equivalent thereof that defines the meets and bounds of the claims.

### ***Claim Rejections - 35 USC § 102***

- The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

### ***Claim Rejections - 35 USC § 103***

- The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

### ***Claim Examination***

\*\* Claim(s) the following claims is/are rejected under 35 U.S.C. 102(b) as being anticipated by Bischoff et al. (5843141).

-- In reference to Claim(s) 1 and 94, Bischoff shows (cover sheet) and ( figure 3 )

an electrical contact element 56,  
a seal zone element 66 positioned adjacent the contact element,  
an elongate conductor 36 extending from the proximal end of the Lead 18 into the  
connector 12 where the conductor couples with the contact element, and  
a relatively rigid strut member 14 completely formed from at least one  
electrically insulative material and comprising:  
an outer surface ( near the lead line of numeral 12 );  
an inner surface 68 forming a longitudinal lumen extending through  
the strut 14,  
a seal zone supporting protrusion ( near the lead line of numeral 90, figure 2 ) extending  
from the outer surface and upon which the seal zone element is mounted, and  
a contact supporting protrusion ( near the lead line of numeral 80, figure 3 ) extending  
from the outer surface, longitudinally spaced apart from the seal zone supporting protrusion and  
upon which the contact element is mounted.

\*\* Claim(s) the following claims is/are rejected under 35 U.S.C. 103(a) as being unpatentable  
over Bischoff.

-- In reference to Claim(s) 91, Bischoff shows substantially the invention as claimed.

However, it is not clear if the material the seal zone element 66 of Bischoff is made of  
formed from a material selected from the group consisting of glass fiber-filled polymer and  
ceramic.

It would have been obvious to one of ordinary skill in the art at the time the invention  
was made to pick such a material, since it has been held to be within the general skill of a

worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416 (CCPA 1960).

One skilled in the art would have been motivated to use the particular material to gain market share with the consumers that are comfortable with the performance history associated with the particular material.

**\*\* Claim(s) the following claims is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer, Sr. et al. (6167314) in view of Bischoff.**

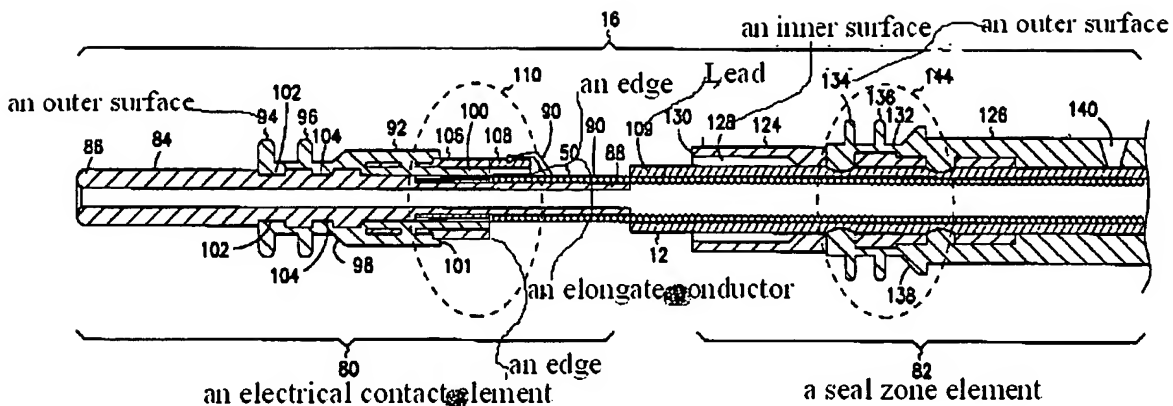
-- In reference to Claim(s) 75, Fischer shows (see examiner's figure) substantially the invention as claimed.

However, while Fischer shows ( figure 1 ) a strut member 24, Fischer does not explicitly show does not show the structure associated with the rigid strut member supporting the contact element.

Bischoff shows (cover sheet) the strut member 14 of housing 12 supporting the contact element 56.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the strut member 14 of Bischoff with the invention of Fischer because it is obvious that Fischer connects to something, but Fischer does not identify it and the housing and strut arrangement of Bischoff shows a reliable sealable housing.

One skilled in the art would have been motivated to look to Bischoff in order to gain the reliability associated with the sealed housing and strut arrangement of Bischoff.



- In reference to Claim(s) 2, 32, and 95, Fischer shows the channel 75 ( figure 3b ).
- In reference to Claim(s) 3, 33, and 96, Fischer shows an adhesive backfill 140 (cover sheet).
- In reference to Claim(s) 5,35, and 98, Fischer shows the adhesive and the inner surface ( near the lead line of numeral 14 (cover sheet) ) as claimed.
- In reference to Claim(s) 6,36, 76, Bischoff shows a lead body mounting surface 68 (figure 2).
- In reference to Claim(s) 14, and 44, Bischoff shows ( figure 2 ) a keying feature 116.
- In reference to Claim(s) 16 and 46, the outer surfaces of Bischoff are flush.
- In reference to Claim(s) 17, 47, 93, and 103, Fischer as modified by Bischoff shows (see examiner's figure) the recessed outer surface and relating seal zone.
- In reference to Claim(s) 18, 19, 22-26, 29, 48, 49, 52-56, 59, 83, 84, 85-89, 104, 105, and 108-112, Fischer as modified by Bischoff shows substantially the invention as claimed.

However, the references do not explicitly show all the claimed materials.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use such materials, since it has been held to be within the general skill of a worker

in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416 (CCPA 1960).

One skilled in the art would have been motivated to use the materials to gain market share associated with customers that feel comfortable with the reliability of the particular material.

-- In reference to Claim(s) 20, 21, 50, 51, 92, 106, and 107, Fischer as modified by Bischoff shows substantially the invention as claimed.

However, the attributes by changing the size of the references to meet the claim language is not shown by the reference.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to change the size of the invention of Fischer as modified by Bischoff, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 and (CCPA 1955), In re Dailey, 149 USPQ 47 (CCPA 1976)

One skilled in the art would have been motivated to change the size in order to reduce the overall bulkiness of the invention of Fischer as modified by Bischoff or to make the invention of Fischer as modified by Bischoff less likely to fail.

-- In reference to Claim(s) 30-60, Fischer as modified by Bischoff shows substantially the invention as claimed. Claims 30-60 are seen as a duplication of the parts that have already been discussed herein.



It would have been obvious to one of ordinary skill in the art at the time the invention was made to duplicate the parts of Fischer as modified by Bischoff.

One skilled in the art would have been motivated to duplicate the parts to make the invention of Fischer as modified by Bischoff more reliable.

**\*\* Claim(s) 15 and 45 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Bischoff.**

-- In reference to Claim(s) 15 and 45, the second part is seen to be a duplication of the parts of Bischoff.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to duplicate the parts, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8 .

One skilled in the art would have been motivated to duplicate the part in order to make the invention of Bischoff more reliable.

#### ***Allowable Subject Matter***

- Claim(s) the following claims has(have) allowable subject matter.
- Claim(s) the following claims are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
- The following is a statement of reasons for the indication of allowable subject matter: The prior art does not show the unique structure of:

-- In reference to Claim(s) 4, 34, and 97, neither Bischoff or Fischer show the combination relating to a longitudinal channel facilitating application of the adhesive backfill from an end of the strut.

-- In reference to Claim(s) 7, 8,9,11,12,37, 38,39,41,42,80,81,77,78,99 and 101, neither Bischoff or Fischer show the combination of the end cap and one of the contact and seal zone elements is held between the end cap and another of the contact and seal zone elements.

-- In reference to Claim(s) 13,43,82, neither Bischoff or Fischer show the combination a connector pin as claimed.

This structure, in combination with all the other elements of the claim is not seen to be anticipated by the prior art and the examiner knows of no permissible motivation to combine the prior art such that the subject matter as a whole would have been obvious at the time the invention was made.

- If the application becomes allowable, any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowable Subject Matter".

### ***Conclusion***

- The prior art listed on PTO form 892 that is made of record and not relied upon is considered pertinent to applicant's disclosure because it shows the state of the art with respect to applicant's claimed invention.
- Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Harvey whose telephone number is 571-272-2007. If

attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on 571-272-2800 extension 33.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2800.

- Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James R. Harvey;  
Examiner

A handwritten signature in black ink, appearing to read 'J-R-H', with a long horizontal line extending to the right.

jrh  
December 12, 2005